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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,441	01/08/2002	Lloyd J. Payne	1768	1447
24264	7590	07/27/2004	EXAMINER	
TIMOTHY J MARTIN, PC 9250 W 5TH AVENUE SUITE 200 LAKEWOOD, CO 80226			EPPERSON, JON D	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/868,441

Applicant(s)

PAYNE ET AL.

Examiner

Jon D Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 and 20-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
  - I. Claims 1-15, drawn to a method for “preparing a polyamine compound.”
  - II. Claims 20-21, drawn to a method for “preparing a plurality of different polyamine compounds” (i.e., a library).
  - III. Claims 22, 25-27, drawn to a product described as a “chemical compound” prepared by the process recited therein.
  - IV. Claims 23-24, drawn to a product described as a “library of compounds” prepared by the process recited therein.
2. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
3. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons that follow.
4. PCT Rule 13.2 states that unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding “special technical features.” It further defines “special technical feature” as “those technical features that define a contribution which each of the claimed inventions, claimed as a whole, makes over the prior art.”

5. Here, the technical feature that links all of the claims is a “compound” that is produced by the incorporation of compounds of formula I and II (e.g., see claims 1-2). The groups lack unity because this special technical feature is known in the art as disclosed by Nash et al. (Nash et al. *Tetrahedron Letters* **1996**, 37(15), 2625-2628). This reference is described below.

6. Nash et al disclose incorporating a molecule of formula I (e.g., see page 2626, scheme 1, compound 6 wherein SS is the 2-chlorotrityl chloride polystyrene resin and NR-RC-NH- is represented by the  $\text{NH}_2\text{-(CH}_2\text{)}_3\text{-N(Boc)-(CH}_2\text{)}_4\text{-N(Boc)-(CH}_2\text{)}_3\text{-NH-}$ ) with a molecule of formula II (e.g., see page 2626, scheme 1, wherein the  $\text{-NR1-Rb-L}$  is represented by the Activated Fmoc-L-Tyr-(<sup>t</sup>Bu)-OH) to form a product that is eventually cleaved from the column (e.g., see compound (1) on page 2625).

7. In addition, Groups I-IV represent separate and distinct inventions. Groups I-II are drawn to different methods and Groups III-IV are drawn to different products and/or kits (i.e., e.g., which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s), screening of different characteristics, such as different binding affinities, different biochemical reaction conditions, etc. or lead to different final results). Therefore, the groups that describe these products and methods have different issues regarding patentability and enablement, and represent patentably distinct subject matter, which merits separate and burdensome searches. Art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render

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obvious another group, because they are drawn to different inventions that have different distinguishing features.

8. For example, Groups I and II represent distinct methods. The methods are distinct because they use different steps, require different reagents and/or will produce different results. For example, Group II has method steps for synthesizing a library, whereas Group I is drawn to method steps for synthesizing only single compounds. Different reagents, materials and method steps are required to produce a library and a library is also used for a different purpose than a single compound. Therefore, art anticipating or rendering obvious each Group would not render obvious the other Group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Therefore, Groups I and II have different issues regarding patentability and enablement and represent patentably distinct subject matter.

9. Likewise, Groups III and IV represent patentably distinct products. Groups III and IV represent separate and patentably distinct products because they differ in respect to their properties, their use and the synthetic methodology for making them. For example, Group IV is drawn to a library, whereas Group III is drawn to single compound. Different reagents and materials are required to produce a library and a library is also used for a different purpose than a single compound. Therefore, art anticipating or rendering obvious each Group would not render obvious the other Group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Consequently, Groups III-IV have different issues regarding patentability and enablement and represent patentably distinct subject matter.

10. Finally, Groups I/III and II/IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the products can be made with another materially different process e.g., solution-phase synthesis.

11. Therefore, the technical feature linking the inventions of groups I-IV does not constitute a species technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Accordingly, groups I-IV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

12. Also see MPEP 1850: Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By dependent claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression category of claim referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

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13. Finally, see 37 CFR § 1.475 - Unity of invention before the International Searching

Authority, the International Preliminary Examining Authority and during the national stage, cited in part below (especially sections (c) and (d)).

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression special technical features shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

A product and a process specially adapted for the manufacture of said product;

or

A product and process of use of said product; or

A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

A process and an apparatus or means specifically designed for carrying out the said process; or

A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

14. The instant application contains multiple products and methods. The first method for producing a product (i.e., Group I) is not linked with said product (i.e., Group III) because the technical feature that links the Group I with Group III is known in the art, as set forth above.

Thus, the instant claims lack unity of invention.

### *Species Election*

15. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked to form a single general inventive concept under PCT Rule 13.1.

16. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species. Claims 1 is generic.

#### Subgroup 1: Species of compound shown in formula I (e.g., see claim 1)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula I. Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula I. Applicant should NOT use general notations like SS, R, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

#### Subgroup 2: Species of compound shown in formula II (e.g., see claim 1)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula II. Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula II. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

#### Subgroup 3: Species of product (e.g., see claim 1)

Applicant must elect for purposes of search a *single species* of product (i.e., one compound). Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula I. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected.



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Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 4: Species of derivatized compound/product if present (e.g., see claim 1)

Applicant must elect for purposes of search a *single species* of derivatized compound (i.e., one compound). Furthermore, applicant must show *all* atoms and bonds that are necessary to define said derivatized compound. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 5: Species of first reagent if present (e.g., see claim 7)

Applicant must elect for purposes of search a *single species* of first reagent (i.e., one compound). Furthermore, applicant must show *all* atoms and bonds that are necessary to define said first reagent. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must further indicate whether said first reagent is difunctional (e.g., see claim 8)

17. If applicant elects the invention of Group II, applicant is required to elect from the following patentably distinct species. Claim 20 is generic.

Subgroup 1: Species of compound shown in formula I (e.g., see claims 20-21)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula I. The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 2: Species of compound shown in formula II (e.g., see claims 20-21)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula II. The election should result in a *particularly defined* core

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structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible.

However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 3: Species of product (e.g., see claims 20-21)

Applicant must elect for purposes of search a *single species* of product (i.e., one compound). The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 4: Species of derivatized compound/product if present (e.g., see claims 20-21)

Applicant must elect for purposes of search a *single species* of derivatized compound (i.e., one compound). The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 5: Species of first reagent if present (e.g., see claims 20-21)

Applicant must elect for purposes of search a *single species* of first reagent (i.e., one compound). The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must further indicate whether said first reagent is difunctional (e.g., see claim 8)

18. If applicant elects the invention of Group III, applicant is required to elect from the following patentably distinct species. Claim 22 is generic.

Subgroup 1: Species of compound shown in formula I (e.g., see claim 22)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula I. Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula I. Applicant should NOT use general notations like SS, R, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 2: Species of compound shown in formula II (e.g., see claim 22)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula II. Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula II. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 3: Species of compound shown in formula III (e.g., see claim 25)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula III. Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula III. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 4: Species of compound shown in formula VII (e.g., see claim 26)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula VII. Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula VII. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

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Subgroup 5: Species of product (e.g., see claim 22)

Applicant must elect for purposes of search a *single species* of product (i.e., one compound). Furthermore, applicant must show *all* atoms and bonds that are necessary to define said compound of general formula I. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 6: Species of derivatized compound/product if present (e.g., see claim 22)

Applicant must elect for purposes of search a *single species* of derivatized compound (i.e., one compound). Furthermore, applicant must show *all* atoms and bonds that are necessary to define said derivatized compound. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 7: Species of first reagent if present (e.g., see claim 22)

Applicant must elect for purposes of search a *single species* of first reagent (i.e., one compound). Furthermore, applicant must show *all* atoms and bonds that are necessary to define said first reagent. Applicant should NOT use general notations like SS, R<sup>1</sup>, R<sup>C</sup>, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. Applicants must further indicate whether said first reagent is difunctional.

19. If applicant elects the invention of Group IV, applicant is required to elect from the following patentably distinct species. Claim 23 is generic.

Subgroup 1: Species of compound shown in formula I (e.g., see claims 23-24)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula I. The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library

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must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 2: Species of compound shown in formula II (e.g., see claims 23-24)

Applicant must elect for purposes of search a *single species* of compound (i.e., one compound) shown in formula II. The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 3: Species of product (e.g., see claims 23-24)

Applicant must elect for purposes of search a *single species* of product (i.e., one compound). The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 4: Species of derivatized compound/product if present (e.g., see claims 23-24)

Applicant must elect for purposes of search a *single species* of derivatized compound (i.e., one compound). The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected. Applicants must also indicate the solid support and show any and all chemical linkages to the solid support i.e., the SS portion. In addition, Applicants must indicate all portions of the molecule i.e., SS, R, R<sup>C</sup>, P<sup>1</sup>, etc.

Subgroup 5: Species of first reagent if present (e.g., see claims 23-24)

Applicant must elect for purposes of search a *single species* of first reagent (i.e., one compound). The election should result in a *particularly defined* core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a *representative example* of the library must be elected.

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Applicants must further indicate whether said first reagent is difunctional (e.g., see claim 8)

20. **Please Note:** Applicants must disclose which claims read on the elected species (see paragraphs 25 and 26 below).

21. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons.

22. PCT Rule 13.2 states that unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". It further defines "special technical feature" as "those technical features that define a contribution which each of the claimed inventions, claimed as a whole, makes over the prior art". For example, unity of invention is fulfilled if:

- (a) all alternatives have a common property; **and**
- (b) (i) a common structure is present, i. e. a significant structural element is shared by all alternatives, or
- (b) (ii) in cases where the common structure can not be the unifying criterion, all alternatives belong to a recognized class of compounds in the art to which the invention pertains. (MPEP 1850).

23. In the instant case, the molecules in subgroups I-IV do not have a common property or significant common structure. Furthermore, the methods for observation require different method steps and different reagents for detection.

For these reasons, election under these rules is proper and required.

24. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

25. Applicant is advised that a reply to this requirement *must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.* An argument that a claim is allowable or that all claims are generic is considered *nonresponsive* unless accompanied by an election.

26. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, *applicant must indicate which are readable upon the elected species.* MPEP § 809.02(a).

27. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

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28. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.  
July 26, 2004

BENNETT CELSA  
PRIMARY EXAMINER

